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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,434	10/17/2002	Cheng-Shing Lai	IACP0024USA	6762
27765	7590	02/24/2005	EXAMINER	
NORTH AMERICA INTERNATIONAL PATENT OFFICE (NAIPC)			GILLIS, BRIAN J	
P.O. BOX 506			ART UNIT	PAPER NUMBER
MERRIFIELD, VA 22116			2141	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/065,434	LAI ET AL.	
	<b>Examiner</b> Brian Gillis	<b>Art Unit</b> 2141	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 17 October 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-6 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 October 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION*****Drawings***

The drawings are objected to because figures 3-5 are unreadable. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Wantanabe et al (US Patent #6,850,757).

(Claim 1 discloses) an electronic mail retrieval and notice system for cellular phones, comprising: a mail service subsystem for retrieving e-mails to generate retrieval information (Wantanabe et al shows a mail client accessing a mail server to retrieve e-mail (column 2, lines 40-46).); and a wireless communication subsystem for receiving and transmitting radio signals (Wantanabe et al shows a communication vendor mail server which performs wireless communication with a cellular phone (column 2, lines 47-52).); wherein when an e-mail is sent to an e-mail box of a user, the mail service subsystem retrieves the e-mail according to an index so as to determine whether to generate retrieval information (Wantanabe et al shows a user must set the apparatus to request transmitting arrival notification mail to be sent to the user (column 3, lines 42-52).), and after the retrieval information is generated, the wireless communication subsystem wirelessly transmits the retrieval information to a cellular phone, which is assigned by the user, so that the cellular phone can display the retrieval information (Wantanabe et al shows the communication vendor mail server sends an arrival notification mail to the cellular phone of the user (column 5, lines 23-31, column 6, lines 1-11)).

(Claim 2 discloses) the electronic mail retrieval and notice system of claim 1 wherein when the cellular phone displays the retrieval information, the user can use the

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cellular phone to transmit a request associated with the retrieval information to the electronic mail retrieval and notice system so as to transmit the e-mail to the cellular phone via the wireless communication subsystem (Wantanabe et al shows that once the notification is sent the user of the cellular phone can determine whether the mail should be read by checking the contents of the mail (column 6, lines 17-26)).

(Claim 3 discloses) the electronic mail retrieval and notice system of claim 1 wherein the mail service subsystem comprises a user setting file for storing settings of a plurality of users and the index is recorded in the user setting file, and the mail service subsystem retrieves e-mails of the users according to the user setting file (Wantanabe et al shows a table in Figure 3 and the flags that are set to determine if a user is to receive the notification mail is saved to the hard disk section which also contains the table (column 3, lines 47-49, 57-62).), thereby generating proper retrieval information and then transmitting the retrieval information to corresponding cellular phones via the wireless communication subsystem (Wantanabe et al shows the communication vendor mail server sending an arrival notification mail to the cellular phone of the correct user (column 6, lines 7-11)).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wantanabe et al (US Patent #6,850,757) in view of Lazaridis et al (US Patent #6,219,694).

Claim 4 discloses the electronic mail retrieval and notice system of claim 1 wherein the index comprises sender name, sender address, mailing date/time, mail subject, or key words created by the user. Wantanabe et al teaches of the limitations of claim 1 as recited above (column 2, lines 40-52, column 3, lines 42-52, column 5, lines 23-31, column 6, lines 1-11). It fails to teach of the index comprising of a sender name, sender address, mailing date/time, mail subject or keywords created by the user. Lazaridis et al teaches of a preferred list which causes a redirector program to act like a filter, redirecting items based on whether the sender is on the list or other message characteristics which are widely known in the art to be mailing date/time, subject, or keywords (column 8, lines 3-11).

Wantanabe et al and Lazaridis et al are analogous art because they are both related to data notification.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the preferred list in Lazaridis et al with the retrieval and notice system of Wantanabe et al because due to bandwidth limitations, only a portion of data can be transferred to the user's mobile device this allows for the user preferred data to only be transferred (column 1, lines 19-24).

Claims 5 and 6 disclose the electronic mail retrieval and notice system of claim 1 wherein the user can use the cellular phone or a computer to adjust the content of the

index. Wantanabe et al teaches of the limitations of claim 1 as recited above (column 2, lines 40-52, column 3, lines 42-52, column 5, lines 23-31, column 6, lines 1-11). It fails to teach of allowing the user to use a cellular phone or a computer to adjust content of the index. Lazaridis et al teaches of a preferred list being configured by the user either at a host computer or the user's mobile data communication device by transmitting a command message (column 7, lines 65-66, column 8, lines 1-2).

Wantanabe et al and Lazaridis et al are analogous art because they are both related to data notification.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the configuring by cellular phone or computer method in Lazaridis et al with the retrieval and notice system of Wantanabe et al because flexibility is provided in configuring the system to respond to numerous events (column 4, lines 57-59).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Paul, JR et al (US PGPUB US2002/0169835) teaches of an e-mail communications system. Skladman et al (US PGPUB US2002/0159575) teaches of filtering notifications of e-mail messages. Fuchigami (US Patent #6,393,463) teaches of an electronic mail communication system. Tett (US Patent #5,604,788) teaches of a wireless messaging system with electronic mail replication. Wang (US Patent #5,956,521) teaches of an electronic mail delivery system. Gupte et al (US PGPUB US2001/0034225) teaches of delivery electronic mail to a wireless communication

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device. Chen et al (US Patent #6,510,455) teaches of an electronic mail checking system. Lai et al (US PGPUB US2002/0078155) teaches of receiving messages by an electronic device. Lai et al (US PGPUB US2002/0156851) teaches of apparatus that can receive a long e-mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gillis whose telephone number is 571-272-7952. The examiner can normally be reached on M-F 7:45-4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian Gillis  
Examiner  
Art Unit 2141

BJG  
2/18/05



RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER